

REMARKS

Applicant respectfully requests reconsideration and allowance of this application in view of the amendments above and the following comments.

Claim 1 is amended to make an editorial change. New claims 10 and 11 are added, which new claims are supported by page 1, lines 25-29. Applicant does not believe that the new claims introduce any new matter. An early notice to that effect is earnestly solicited.

The sole issue for consideration is the rejection of claims 1-9 under 35 USC § 102(b) as being anticipated by Takeuchi et al. (“Takeuchi”), US 4,856,857. In response, Applicants would remind the Examiner that anticipation requires that each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference, and, further, if the Examiner relies on a theory of inherency as to any particular element, then the extrinsic evidence must make clear that such element is *necessarily* present in the thing described in the reference, and the presence of such element therein would be so recognized by persons skilled in the art. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Further, inherency is not established by probabilities or possibilities, and the mere fact that a property may result from a given circumstances is not sufficient; instead it must be shown that such property *necessarily* inheres in the thing described in the reference. *Id.* The rejected claims require that the thickness of the at least one layer “varies locally in thickness *in order to form* an image.” Takeuchi does not teach this limitation and, therefore, does not anticipate the instant claims.

Image formation in Takeuchi’s invention is not dependent on the varying thickness of areas of the composition. Instead, Takeuchi teaches the production of holograms by refraction of light of a diffraction pattern laid down as an interference fringe in the composition. Although the composition is given an uneven surface in the production of the interference fringe, the hologram is not due to the unevenness of the

